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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,540	01/23/2004	Guann-Pyng Li	UC1.PAU.32	7506

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EXAMINER
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TOWA, RENE T

ART UNIT	PAPER NUMBER
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3736

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/30/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

4A

<b>Office Action Summary</b>	<b>Application No.</b> 10/763,540	<b>Applicant(s)</b> LI ET AL.	
	<b>Examiner</b> Rene Towa	<b>Art Unit</b> 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,4-6,8,13,14,16,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-6,8,13,14,16,19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This Office action is responsive to an amendment filed November 16, 2006. Claims 1, 4-6, 8, 13-14, 16 and 19-20 are pending. Claims 1, 4, 8, 13-14, 16, and 19 have been amended. Claims 21-44 are withdrawn. No new claim has been added.

#### ***Claim Objections***

2. The objections are withdrawn due to amendments.

#### ***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Kuo (US Patent No. 6,623,698).

Kuo discloses an apparatus for making a physiological test comprising:

an oral platform 6 ;

a microchip (i.e. matrix of sensors 138, 140) mounted on or in the platform 6 for making medical diagnoses; and

a stick 2 connected to the platform 6 to serve as a handle on the platform 6 for exterior communication with the microchip (see figs. 1a, 4a-c & 5a-c; column 6/lines 32-54 & 62-67; column 7/lines 1-20; column 8/lines 53-63; column 9/lines 32-50; column 10/lines 25-31; column 16/lines 40-51).

*It is noted that Kuo discloses an apparatus wherein the handle 2 is exterior to the brush head (i.e. platform) and communicates with at least one sensor (i.e. microchip) via a signal lead and/or channel.*

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuo ('698).

Kuo discloses an apparatus where the platform 6 has a plurality of fluidic ports (24, 26) defined therein conducive for communication of saliva to the microchip (see figs. 1c). Although Kuo does not explicitly teach a plurality of separate fluidic ports, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to provide an apparatus similar to that of Kuo with a plurality of separate fluidic ports since such a modification would amount to a design choice that would serve the same purpose of channeling the fluid to the microchip. Moreover, it has previously been held that merely making separable is not patentable--See *In re Dulberg*, 289 F. 2d 522, 523, 129 USPQ 348, 349 (CCPA 1961).

7. Claims 5-6, 8, 13-14, 16 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuo ('698) in view of Feller et al. (US Patent No. 5,897,492) further in view of Lundell et al. (US Patent No. 5,994,855).

**The Examiner notes that "a system" as hereinafter mentioned is intended to refer to either one of "an apparatus" or "a method."**

Kuo discloses a method for making a physiological test comprising:

providing an oral platform 6;

collecting saliva through the oral platform 6;

delivering collected saliva to a microchip (i.e. matrix of sensors 138, 140) mounted in the platform 6; and

making a medical diagnosis from collected samples of saliva through the platform 6 (see figs. 1a, 4a-c & 5a-c; column 6/lines 32-54 & 62-67; column 7/lines 1-20; column 8/lines 53-63; column 9/lines 32-50; column 10/lines 25-31; column 16/lines 40-51).

Kuo discloses a system, as described above, that teaches all the limitations of the claims except Kuo does not teach a candy shell coating. However, Feller et al. discloses an apparatus 10 comprising a candy shell coating 12; wherein said apparatus is shaped like a lollipop (see fig. 1; column 2/lines 58-64).

Since Kuo teaches interchanging its oral device with other element used for dental or medical functions (see column 16/lines 40-51) and Feller et al. teaches an element used for dental functions, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to provide a system similar to that of Kuo with a candy coating similar to that of Feller et al. in order to reduce the anxiety associated with oral examinations (see Feller et al., column 1/lines 44-53).

Furthermore, Kuo as modified by Feller et al. discloses a system, as described above, that teaches all the limitations of the claims except Kuo as modified by Feller et al. does not teach coupling the system to a cradle unit. However, Lundell et al. disclose a system 10 comprising a cradle unit 28 temporarily being to a base or cradle unit 12 (see fig. 1).

It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to provide a system similar to that of Kuo as modified

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by Feller et al. with a cradle unit similar to that of Lundell et al. in order to recharge the battery as is well known in the art.

Moreover, since Kuo as modified by Feller et al. and Lundell et al. teaches interchanging its oral device with other element used for dental or medical functions (i.e. replacing the bristles with a candy shell) (see rejection supra), it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to provide a system similar to that of Kuo as modified by Feller et al. and Lundell et al. with a plurality of base units which are interchangeable with a plurality of lollipops for making a plurality of medical diagnoses since such a modification would amount to a design choice. It has previously been held that duplicating part for a multiple effect is not patentable--See *In re Harza*, 274 F.2d 669, 671, 124 USPQ 378, 380 (CCPA 1960).

Even moreover, Kuo as modified by Feller et al. as further modified by Lundell et al. discloses an apparatus comprising a data processing communication (34, 35) and display 178 (see Kuo, fig. 5h). As such, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to provide a system similar to that of Kuo as modified by Feller et al. as further modified by Lundell et al. with a cradle unit that provides data processing communication and/or display since such a modification would amount to a design choice that would serve the same purpose of processing and communicating the data. Furthermore, it has previously been held that shifting location of parts (i.e. shifting the location of the data processing) is not patentable--See *In re Japikse*, 181 F. 2d 1019, 1023, 86 USPQ 70, 73 (CCPA 1950).

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Even moreover yet, it has previously been held that duplicating parts (i.e. the processing and communicating parts) for a multiple effect is not patentable--See *In re Harza*, 274 F.2d 669, 671, 124 USPQ 378, 380 (CCPA 1960).

8. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doneen et al. (US Patent No. 6,102,872).

In regards to claim 1, Doneen et al. discloses an apparatus for making a physiological test and/or delivery of drugs comprising:

- an oral platform 10';
- a sensor 30 mounted on the platform for making medical diagnoses; and
- a stick 26 connected to the platform to serve as a handle on the platform for exterior communication with the sensor 30 (see figs. 1-3; column 2/lines 33-47; column 3/lines 44-56; column 5/lines 35-44; column 6/lines 17-21; column 7/lines 31-33 & 40-54).

It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to provide an apparatus similar to that of Doneen et al. with a microchip, as claimed, since such a modification would amount to a design choice that would serve the same purpose of sensing the physiological condition. Moreover, it has previously been held that changing aesthetic design (i.e. the type of sensor) is not patentable--See *In re Seid*, 161 F.2d 229, 231, 73 USPQ 431, 433 (CCPA 1947).

### ***Response to Arguments***

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9. Applicant's arguments filed November 9, 2006 have been considered but are moot in view of the new ground(s) of rejection; however, it is worth noting the following with respect the various arguments.

In regards to claim 1, Applicant argues that Kuo fails to teach an external communication. The Examiner respectfully disagrees. The claim language only requires a stick/handle that is connected to the platform for exterior communication with the microchip. Since Kuo teaches a handle 2 that is exterior to the brush head (i.e. platform) and communicates with at least one sensor (i.e. microchip) via a signal lead and/or channel in the brush head, the Examiner submits that a communication between the microchip, which is located in the platform and a stick/handle, which is exterior to the platform, can be construed as an exterior communication of the microchip from the platform to the handle.

In regards to claim 4, Applicant argues that Kuo fails to disclose a plurality of separate fluidic ports. This argument is now moot in view of the new grounds of rejections.

In regards to claims 5-6, 8, 13-14, 16 and 19-20, Applicant argues that Kuo fails to teach is base unit. Although this argument is now moot in view of the new grounds of rejections, it is noted that absent any special definition set forth in the specification specifically defining a base unit, inter alia, as "an active cooperative device including mechanical support functions," the base unit may be construed as a toothbrush battery charger as further supported by the Applicant's own admission at page 11 of the Remarks "Chips 14 may interact with an optional base unit 18 if they require additional



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resources such as power, fluidic, light, computations or communications” [Emphasis added]. Similarly, a base unit does not seem to distinguish from the cradle unit in that they both provide essentially the same function and are structurally identical excepting the size. It has previously been held that merely changing size is not patentable--see *In re Rose*, 220 F.2d 459, 463, 105 USPQ 237, 240 (CCPA 1955). Moreover, Kuo and Lundell et al. disclose a toothbrush that includes, inter alia, “batteries, computer chips, a display and fluidic reservoirs,” which mechanical functions Applicant attributes to the base and/or cradle unit. As such, it is also noted that shifting location of parts (within the system, i.e. the oral apparatus-cradle unit system) is not patentable--See *In re Japikse*, 181 F. 2d 1019, 1023, 86 USPQ 70, 73 (CCPA 1950).

More in regard to claim 1, Applicant contends that Doneen fails to disclose a microchip. This argument is now moot in view of the new grounds of rejections.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rene Towa whose telephone number is (571) 272-8758.

The examiner can normally be reached on M-F, 8:00-16:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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